

Application No.: 10/539,641
Amdt dated: November 21, 2007
Reply to Office action of: August 22, 2007

REMARKS/ARGUMENTS

This amendment is filed in response to the Office action that was mailed on August 22, 2007. By this Amendment, Claims 1, 4 and 26 are amended and Claim 35 is new. The amendments and new claim do not add new matter as they are fully supported by the Claims, Specification, and/or Drawings as originally filed or are inherent characteristics thereof. Claims 1-6 and 8-35 are pending in the Application. Applicants respectfully request reconsideration and allowance of all Claims in view of the following remarks.

Claims 1-6, 8, 9 and 11 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,497,317 to Boschetti (Boschetti '317). To be anticipating, a prior art reference must disclose each and every limitation of the claimed invention, the prior art must be enabling, and the prior art reference must describe the claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339 (Fed. Cir. 2000).

It is indicated in the Office action that Boschetti '317 discloses a device including a malleable ring member (4) and a membrane or bag (2) fixedly attached to a perimeter of the ring member, wherein the bag is made of cotton, a bias woven fabric (Figs. 1, 3 and 4, column 2, lines 65-68, column 3 and column 4, lines 1-63). Applicant respectfully traverses this rejection.

Application No.: 10/539,641
Amdt dated: November 21, 2007
Reply to Office action of: August 22, 2007

Amended Claim 1 includes the membrane being positioned across the ring member and being substantially taut when the ring member is in a neutral state. Applicant respectfully submits that Boschetti `317 fails to disclose the membrane being taut when the malleable ring is in a neutral state. Boschetti `317 discloses an elastic ring (1) that is placed into a container or bag (2), where the ring resumes its natural state and stretches the container walls into a cup shape (Boschetti `317, FIG. 3 and col. 4, lines 14-24). Being "cup-shaped," the container (2) of Boschetti `317 is slack, and is not substantially taut as disclosed in amended Claim 1 of the present Application. Based on the foregoing, Applicant respectfully submits that Boschetti `317 does not disclose each and every limitation of the invention of Claim 1 and that Claim 1 is allowable over Boschetti `317. Applicant also respectfully submits that Claims 2-6, 8, 9 and 11 are allowable over Boschetti `317 as depending from an allowable claim. Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Claims 1-6, 8, 19, 20 and 26-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,143,082 to Kindberg et al. (Kindberg `082), as evidenced by U.S. Patent No. 4,428,375 to Ellman (Ellman `375). In the Office action it is indicated that Kindberg `082 discloses a surgical device to temporarily reposition body tissues and organs including a ring member having cords (20) and a membrane (15) made of a flexible material that could be a mesh structure (FIGS. 1-3, col. 2, lines 56-68, col. 3 and col. 4, lines 1-56). It is also indicated in the Office action that Kindberg `082 refers to Ellman `375 for examples of pliable surgical materials having a

Application No.: 10/539,641
Amdt dated: November 21, 2007
Reply to Office action of: August 22, 2007

mesh structure and that Ellman `375 discloses a mesh construction with woven or knitted strands (Ellman `375, col. 2, lines 18-68). Applicant respectfully traverses this rejection.

As indicated above, Amended Claim 1 includes the membrane being positioned across the ring member and being substantially taut when the ring member is in a neutral state. Independent Claim 26 was similarly amended to include the membrane being positioned across the ring member and being substantially taut when the ring member is in a neutral state. Applicant respectfully submits that Kindberg `082 fails to disclose the membrane being substantially taut when the ring member is in a neutral state. The ring member (12) of Kindberg `082 is positioned at the opening of a bag (15) (Kindberg `082, FIGS. 1-3). In the open and closed conditions of the ring member (12) and bag (15) of Kindberg `082, the bag is shown to be hanging below the ring member (12). Hence, the bag (15) of Kindberg `082 is slack and is not substantially taut as disclosed in amended Claims 1 and 26 of the present Application. Based on the foregoing, Applicant respectfully submits that Kindberg `082 does not disclose each and every limitation of the invention of Claims 1 and 26 and that Claims 1 and 26 are allowable over Kindberg `082. Applicant also respectfully submits that Claims 2-6, 8, 19 and 20 are allowable over Kindberg `082 as depending from allowable Claim 1 and that Claims 27-29 are allowable over Kindberg `082 as depending from allowable Claim 26. Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Application No.: 10/539,641
Amdt dated: November 21, 2007
Reply to Office action of: August 22, 2007

Claims 1, 3-6, 8-13, 26, 27 and 29-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,450,983 to Rambo (Rambo `983) in view of U.S. Patent No. 5,899,942 to Berman (Berman `942). In the Office action it is indicated that Rambo `983 discloses a retraction device with a malleable ring member (10) and a flexible sleeve or membrane (8) attached to a perimeter of the ring wherein the membrane is made from an elastic material (Figs. 1, 6-9, 16, 18, 40-41, 63 and 66, col. 6, lines 3-67, cols. 7-8 and col. 9, lines 1-33). It is also indicated in the Office action that Rambo `983 discloses all elements of the claimed invention except for the membrane (8) being made of a bias-woven or knitted fabric, but that Berman `942 teaches a medically acceptable barrier or membrane material made of a knit or woven polyester fabric (col. 3, lines 52-67 and col. 4, lines 1-12). Applicant respectfully traverses this rejection.

As indicated above, independent Claims 1 and 26 include the membrane being positioned across the malleable ring member and being substantially taut when the ring member is in a natural state. Rambo `983, however, discloses a cylindrical sleeve (8) having first and second ends (16, 18) with the periphery of each end of the sleeve being connected to a ring (10, 12) (Rambo `983, FIG. 1 and col. 6, lines 3-20). Applicant respectfully submits that Rambo `983 fails to teach the membrane being positioned across the ring member, and Berman `942 does nothing to correct this deficiency. Thus, a prima facie case of obviousness is not established and hence reconsideration and withdrawal of the rejection of Claims 1 and 26 are respectfully requested.

Application No.: 10/539,641
Amdt dated: November 21, 2007
Reply to Office action of: August 22, 2007

Applicant also respectfully submits that Claims 3-6 and 8-13 are allowable as depending from allowable Claim 1 and that Claims 27 and 29-31 are allowable as depending from allowable Claim 26. Applicant also respectfully requests that these rejections be reconsidered and withdrawn.

Claims 14-25 and 32-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rambo '983 and Berman '942 in view of U.S. Patent No. 5,161,806 to Balsells (Balsells '806). In the Office action it is indicated that the combination of Rambo '983 and Berman '942 discloses all elements of the claimed invention except for a reinforcement member in the ring to adjust the flexibility of the ring. It is further indicated in the Office action that it is well known to modify the flexibility of a hollow ring by reinforcing the ring using a metallic component (14) embedded in a plastic component as demonstrated by Balsells '806 (col. 2, lines 1-12). Applicant respectfully traverses this rejection.

As indicated above, amended independent Claims 1 and 26 are allowable over Rambo '983 and Berman '942 as having the membrane being positioned across the ring member, and Applicant respectfully submits that Balsells '806 does nothing to correct this deficiency. Thus, a prima facie case of obviousness is not established and hence reconsideration and withdrawal of the rejection of Claims 14-25 and 32-34 are respectfully requested. Applicant further respectfully submits that Claims 14-25 and 32-34 are also allowable as depending from allowable independent claims.

Application No.: 10/539,641
Amdt dated: November 21, 2007
Reply to Office action of: August 22, 2007

Claims 1 and 26 were further amended to remove the limitation of the membrane being a bias-woven or knitted fabric. Applicant respectfully submits that the inclusion of the membrane being positioned across the ring member and the membrane being substantially taut when the ring member is in a neutral state places these claims in condition for allowance over the cited art. Applicant also respectfully submits that the term of the membrane being a bias-woven or knitted fabric, which was added to Claims 1 and 26 in an earlier amendment, is not necessary to maintain Claims 1 and 26 in condition for allowance over the cited art. New Claim 35 is identical to original Claim 7, which was earlier canceled without prejudice.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner believes that a telephone conference with Applicant's attorney might expedite prosecution of the Application, the Examiner is invited to call at the telephone number indicated below.

Sincerely,

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